

## REMARKS

Please note that the Office Action Summary provides no indication of a shortened statutory period for responding to the final Office Action. Applicant, however, submits this Response in good faith within two months of the mailing date of the final Office Action.

Claims 2, 3, 5-22, and 24-40 are currently pending in the application. Claims 2, 3, 5-7, 9-11, 15, 17-19, 24-26, 28-30, 32, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,311,438 to Sellers *et al.* ("Sellers") in view of U.S. Patent No. 6,578,005 to Lesaint *et al.* ("Lesaint"). Claims 8, 14, 16, 22, 27, 33, and 35-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellers in view of Lesaint and U.S. Patent No. 6,671,673 to Baseman *et al.* ("Baseman"). Claims 12, 13, 20, 21, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellers in view of Lesaint and U.S. Patent No. 5,408,663 to Miller ("Miller").

### Rejections Under 35 U.S.C. § 103(a):

As indicated above, all of the pending claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellers in view of Lesaint and, in some rejections, Baseman or Miller. Independent claims 7, 15, 26, and 34 each recite "the set of financial projections for a candidate product providing a future profit determination **for each of a set of possible product introduction dates** for the candidate product" (emphasis added). Applicant respectfully asserts that Sellers fails to disclose or suggest this limitation.

The Office relies upon column 113, lines 44-49 of Sellers to teach the limitation identified above. This portion of Sellers, however, merely teaches "[t]he second detail screen contains results of a present value analysis applied to the estimates entered on the first screen." The estimates referred to are "the expected investment outlays and estimated operating cash flows over the entire economic life of the new product" and "the assumptions and cost estimates used to determine the cash flows" (col. 113, ll. 38-42, of Sellers). The portion of Sellers relied upon by the Office further teaches that the analysis

“provides some basic financial parameters such as the net present value, profitability index, internal rate of return, and the present value payback period.”

Applicant respectfully asserts that Sellers is silent with regard to a set of financial projections for each of a set of possible product introduction dates. Rather, one of ordinary skill in the art would appreciate that Sellers’ financial projections are based on one product introduction date, since Sellers teaches that examples of the financial parameters are the net present value (rather than net present values), profitability index (rather than profitability indices), internal rate of return (rather than internal rates of return), and the present value payback period (rather than present value payback periods). In other words, if Sellers were to generate financial projections for each of a set of possible introduction dates, which Applicant disputes, multiple financial parameters of each type (e.g., net present value, profitability index, *etc.*) would be generated. Accordingly, Sellers fails to teach or suggest to one of ordinary skill in the art a set of financial projections for a candidate product providing a future profit determination ***for each of a set of possible product introduction dates*** for the candidate product, as required by each of the rejected claims. For at least this reason, each of the rejected claims is allowable over Sellers in view of any of the other cited references.

Moreover, independent claim 15 recites “a planning engine operable to...select a set of candidate products that meets all resource availability constraints and maximizes profits.” The Office relies upon column 87, lines 18-23, column 89, lines 5-10, and column 107, lines 5-9, of Sellers to teach this limitation (Detailed Action, p. 4, ll. 2-7). These passages of Sellers and, in fact, Sellers in general, however, teach a system wherein candidate products are selected using human intervention rather than via any planning engine. Note the Office’s construction acknowledges human intervention, e.g., “reviewing production scheduling test specification”, “browse results such a [*sic*] profitability”, and “project definition conversation” (emphasis added) (Detailed Action, p. 4, ll. 4-6). Further, Sellers teaches “[i]f more than one prototype was developed, the research and development scientist uses this screen to indicate preferred solutions” (col. 119, ll. 47-49, of Sellers), which further provides evidence of human intervention rather than a planning engine, as required by claim 15 and the claims dependent thereto.

Further, Sellers fails to teach or suggest a planning engine operable to “generate a development schedule for the selected set of candidate products” in any way, as required by claim 15. Rather, Sellers teaches that milestones are manually inputted:

*The Design Request Project Milestones conversation may be used to document the events and dates used to gauge the development effort's progress. The combination of the overall estimated development time, target completion date, and milestone dates will establish the entire project's timeframe.*

See column 98, lines 24-29, of Sellers. Thus, the development schedule is set by a user of Seller's system, rather than by a planning engine. For at least this additional reason, claim 15 and the claims dependent thereto are allowable over Sellers in view of any of the other cited references.

Independent claim 26 and the claims dependent thereto recite software operable to “generate a development schedule for the set of candidate products.” The Office relies on Sellers to disclose this limitation, as discussed above concerning independent claim 15. Accordingly, claim 26 and the claims dependent thereto are allowable over Sellers in view of any of the cited references for the same reasons set forth above concerning claim 15.

With respect to the combination of Sellers and Lesaint, the Office proposes that Lesaint discloses “that products can be processed in accordance with time constraints” (Detailed Action, pl. 6, ll. 20-21). Claims 7, 15, 26, and 34 each recite “a development schedule for the set of candidate products to maximize profit...**using the financial projections for the candidate products as a weighted factor** in generating the development schedule such that products more affected by time are scheduled for faster production than products less affected by time.” Applicant respectfully submits that Lesaint fails to disclose or suggest any financial projections, as taught by the present application or even by Sellers, to generate a schedule. Rather, Lesaint merely takes in to consideration “financial penalties” for not completing the task on time or arriving to start the task on time. Accordingly, Lesaint fails to teach or suggest this limitation of claims 7, 15, 26, 34, and the claims dependent thereto. The rejected claims, therefore, are allowable over Sellers and Lesaint in view of any of the other cited references.

Applicant maintains that the combination of Sellers and Lesaint is improper. A reference can be asserted against the claimed invention under §103 only if (1) it is within Applicant's field of endeavor, or (2) is reasonably pertinent to the problem facing Applicant even though not within Applicant's field of endeavor. *In re Clay*, 23 U.S.P.Q.2d (BNA) 1058, 1060 (Fed. Cir. 1992).

Lesaint relates to a technique for scheduling tasks to service technicians (col. 1, ll. 14-19, of Lesaint) not to generating a development schedule for candidate products, as does the present invention. Thus, Lesaint is not within Applicant's field of endeavor and can be within the scope and content of the prior art only if it is "reasonably pertinent" to Applicant's invention. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (reversing Board holding of obviousness).

Nor is Lesaint reasonably pertinent to Applicant's invention. Applicant's invention is directed to generating a development schedule using financial projections as a weighted factor. Lesaint, however, is directed to scheduling based on time constraints, using the Office's construction. Thus, even though Lesaint concerns scheduling, it is not reasonably pertinent to Applicant's invention.

The discussion in *Clay* is pertinent to the present case. In addressing the first part of the test for analogous art, the Federal Circuit reasoned:

*The PTO argues that [the reference] and [Applicant's] inventions are part of a common endeavor—"maximizing withdrawal of petroleum stored in petroleum reservoirs." However, [the reference] cannot be considered to be within [Applicant's] field of endeavor merely because both relate to the petroleum industry. ...[Applicant's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of the [reference], on the other hand, is the extraction of crude petroleum. The Board clearly erred in considering [the reference] to be within the same field of endeavor as [Applicant's].*

*Clay*, 23 U.S.P.Q.2d (BNA) at 1060. This reasoning reads directly on the present case with only slight modification for the technologies involved. With respect to the second part of the test, the Federal Circuit, after a discussion of the two inventions, held:

*A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined*

*petroleum by considering a reference dealing with plugging underground formation anomalies. The Board's finding to the contrary is clearly erroneous.*

Clay, 23 U.S.P.Q.2d (BNA) at 1061. Again, with some modification for the involved technologies, the reasoning applies directly to the present case. Lesaint, however, does not deal with the problem of generating a development schedule using financial projections, as does the present invention. Thus, Lesaint is not "reasonably pertinent" to Applicant's invention and is, therefore, outside the scope and content of the prior art.

Accordingly, it is respectfully requested that:

- the rejection of claims 2, 3, 5-7, 9-11, 15, 17-19, 24-26, 28-30, 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Sellers in view of Lesaint;
- the rejection of claims 8, 14, 16, 22, 27, 33, and 35-40 under 35 U.S.C. § 103(a) as being unpatentable over Sellers in view of Lesaint and Baseman; and
- the rejection of claims 12, 13, 20, 21, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Sellers in view of Lesaint and Miller

be reconsidered and withdrawn in light of the above remarks and the legal standard for obviousness provided below.

#### **The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

## CONCLUSION


The Applicant submits that all of the Examiner's rejections are hereby traversed and overcome. The Applicant respectfully submits that the Examiner has not shown by clear and convincing evidence that the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made in light of the cited references. For the reasons set forth herein, the Applicant submits that claims 2, 3, 5-22, and 24-40 are now in condition for allowance, and respectfully requests that claims 2, 3, 5-22, and 24-40 be allowed.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. **500777**. Should the balance in this deposit account be insufficient to fund the required fees, the undersigned hereby authorizes the Commissioner to alternatively charge any additional fees that may be required to Deposit Account No. **502806**.

**Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.**

Respectfully submitted,

3/25/05  
Date

  
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**CUSTOMER NO. 38441**

**ATTORNEYS AND AGENT FOR APPLICANT**